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OCT 21 2005

OFFICE OF PETITIONS

In re Application of
Klinefelter
Application No. 09/752,514
Filed: January 3, 2001
Attorney Docket No. ISA-013.03
For: METHOD FOR EVALUATING AND
AFFECTING MALE FERTILITY

ON PETITION

This is a decision on the petition under 37 CFR 1.137(a), requesting revival of the above-identified application, and the petition under 37 CFR 1.181, requesting withdrawal of the holding of abandonment of the above-identified application. Both petitions were filed on September 22, 2005 via facsimile.

The petition under 37 CFR 1.181 is **DISMISSED**.

The petition under 37 CFR 1.137(a) is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted.

This application was held abandoned for failure to timely submit the issue fee and publication fee within three months of the mailing of the September 30, 2004 Notice of Allowance and Fee(s) Due. Applicant submitted a completed Part B-Fee(s) Transmittal on January 3, 2005 (certificate of mailing date December 29, 2004) that contained authorization for the Office to charge deposit account no. 06-1448 the issue fee, the publication fee, advance copies of the future patent, and all other required fees. The Office contended that this application became abandoned on December 30, 2004 because deposit account no. 06-1448 did not contain sufficient funds to charge the required fees on January 5, 2005, when a member of the Office attempted to charge the fees. The filing of the instant petitions precedes the mailing of A Notice of Abandonment.

PETITION UNDER 37 CFR 1.181

Petitioner asserts that the deposit account had sufficient funds on January 4, 2005 to charge the required fees. Therefore, petitioner argues that the application never went abandoned because the Office should have charged the fees to practitioner's deposit account, as was authorized.

While the Notice of Fee(s) Due states that on January 4, 2005 there were insufficient funds to charge the required fees, it is noted that a member of the Office of Initial Patent Examination attempted to charge the required fees on January 5, 2005, not January 4, 2005, as evidenced by the snapshot financial record present in the electronic record of this application. On January 5, 2005, when the Office employee attempted to charge the required fees to practitioner's deposit account, only \$11.00 was present. There were insufficient funds in the deposit account to cover the charges on the date and time that the Office attempted to collect the fees due for this application.

The petition under 37 CFR 1.181 is dismissed.

PETITION UNDER 37 CFR 1.137(a)

A grantable petition under 37 CFR 1.137(a) must be accompanied by: (1) the required reply, unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(l); (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c). The instant petition lacks item (3).

Regarding (3) above, petitioner has not shown to the satisfaction of the Commissioner that the entire delay from the due date of the issue fee to the filing of a grantable petition was unavoidable.

Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.

In re Mattullath, 38 App. D.C. 497, 514-15 (1912)(quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

An adequate showing of **diligence** is the touchstone of a successful petition to revive under an unavoidable standard. As stated above, practitioner's deposit account did not contain sufficient funds on January 5, 2004 to cover the required fees. Not retaining enough money in the deposit account was what caused the application to go abandoned. Practitioner was responsible for monitoring and maintaining his deposit account. It was practitioner's responsibility to ensure that an adequate amount of money was present in the deposit account to pay authorized patent bills at all times. Practitioner did not fulfill this responsibility.

The petition under 37 CFR 1.137(a) is dismissed.

ALTERNATE VENUE-- PETITION UNDER 37 CFR 1.137(b)

The undersigned strongly suggests filing a petition stating that the delay was unintentional. Public Law 97-247, § 3, 96 Stat. 317 (1982), which revised patent and trademark fees, amended 35 U.S.C. § 41(a)(7) to provide for the revival of an "unintentionally" abandoned application without a showing that the delay in prosecution or in late payment of an issue fee was "unavoidable." This amendment to 35 U.S.C. § 41(a)(7) has been implemented in 37 CFR 1.137(b). An "unintentional" petition under 37 CFR 1.137(b) must be accompanied by the \$1,500.00 petition fee.

The filing of a petition under 37 CFR 1.137(b) cannot be intentionally delayed and therefore must be filed promptly. A person seeking revival due to unintentional delay can not make a statement that the delay was unintentional unless the entire delay, including the delay from the date it was discovered that the application was abandoned until the filing of the petition to revive under 37 CFR 1.137(b), was unintentional. A statement that the delay was unintentional is not appropriate if petitioner intentionally delayed the filing of a petition for revival under 37 CFR 1.137(b). For petitioner's convenience, please find enclosed a blank PTO/SB/64 -- Petition for Revival of an Application for Patent Abandoned Unintentionally under 37 CFR 1.137(b).

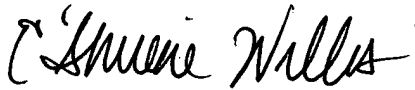
Further correspondence with respect to this matter should be addressed as follows:

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By hand: U.S. Patent and Trademark Office
Customer Service Window, Mail Stop Petition
Randolph Building
401 Dulany Street
Alexandria, VA 22314

By FAX: (571) 273-8300 - ATTN: Office of Petitions

Telephone inquiries concerning this matter may be directed to the undersigned at (571) 272-3230.



E. Shirene Willis
Senior Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

enclosures: blank PTO/SB/64 -- Petition for Revival of an Application Abandoned
Unintentionally under 37 CFR 1.137(b)

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